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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,185	08/27/2001	Kevin Gunderson	A-69605-1/DJB/RMS/DCF	3512

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EXAMINER

EINSMANN, JULIET CAROLINE

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 11/19/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/940,185

Applicant(s)

GUNDERSON ET AL.

Examiner

Juliet C Einsmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-13, drawn to an oligonucleotide array, classified in class 435, subclass 287.2.
  - II. Claims 14-15, drawn to methods of immobilizing targets, classified in class 435, subclass 6.
  - III. Claim 16, drawn to methods of detecting a target nucleic acid, classified in class 435, subclass 6.

### **Further Restriction Requirement for Each Group**

Portions of MPEP 803.04 are repeated herein for Applicant's convenience.

"Examples of typical nucleotide sequence claims impacted by the partial waiver of 37 CFR 1.141 et seq. (and the partial waiver of 37 CFR 1.475 and 1.499 et seq., see MPEP § 1850) include...C) a combination of DNA fragments, said combination containing at least thirty different DNA fragments selected from SEQ ID Nos. 1-1,000...Applications containing only composition claims reciting different combinations of individual nucleotide sequences, such as set forth in example (C), will be subject to a restriction requirement. Applicants will be required to select one combination for examination. If the selected combination contains ten or fewer sequences, all of the sequences of the combination will be searched. If the selected combination contains more than ten sequences, the combination will be examined following the procedures set forth above for example (B). More specifically, the combination will be searched until one nucleotide sequence is found to be allowable with the examiner choosing the order of search to maximize the identification of an allowable sequence. The identification of any allowable sequence(s) will cause all combinations containing the allowed sequence(s) to be allowed."

Group I includes claims that recite groupings of at least 25 different capture probes, and also contains dependent claims that recite groupings of 50 and 100 different capture probes

selected from Tables 1-4 of the specification. Thus, the claims read on a multitude of groupings of probes, each of which is separate and distinct one from another because they contain nucleic acid sequences that are structurally separate from one another. The search and examination of all possible groups would pose an enormous burden on the examiner and on the PTO search resources. In accordance with MPEP 803.04, applicant is required to select one combination of capture probes selected from the group consisting of the sequences set forth in Table 1, Table 2, Table 3, and Table 4. Upon election of the single combination, applicant should identify where in the appropriate table each sequence is recited and applicant should further identify the combination of sequences by proper SEQ ID NO. If the single combination selected by applicant contains less than 50 or 100 capture probes, claims 7, 8, 10, and 11 will be treated as non-elected claims, as appropriate.

Group II includes claims that require the selection of a first adapter sequence from Table 1, Table 2, Table 3, or Table 4 and also recite groupings of at least 25 different capture probes, and also contains dependent claims that recite groupings of 50 and 100 different capture probes selected from Tables 1-4 of the specification. Thus, the claims read on a multitude of groupings of probes, each of which is separate and distinct one from another because they contain nucleic acid sequences that are structurally separate from one another. The search and examination of all possible groups would pose an enormous burden on the examiner and on the PTO search resources. In accordance with MPEP 803.04, applicant is required to select one combination of capture probes selected from the group consisting of the sequences set forth in Table 1, Table 2, Table 3, and Table 4. Upon election of the single combination, applicant should identify where

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in the appropriate table each sequence is recited and applicant should further identify the combination of sequences by proper SEQ ID NO.

Group III includes claims that require the selection of a first adapter sequence from Table 1, Table 2, Table 3, or Table 4 and also recite groupings of at least 25 different capture probes, and also contains dependent claims that recite groupings of 50 and 100 different capture probes selected from Tables 1-4 of the specification. Thus, the claims read on a multitude of groupings of probes, each of which is separate and distinct one from another because they contain nucleic acid sequences that are structurally separate from one another. The search and examination of all possible groups would pose an enormous burden on the examiner and on the PTO search resources. In accordance with MPEP 803.04, applicant is required to select one combination of a first adapter sequence and at least 25 capture probes selected from the group consisting of the sequences set forth in Table 1, Table 2, Table 3, and Table 4. Upon election of the single combination, applicant should identify where in the appropriate table each sequence is recited and applicant should further identify the combination of sequences by proper SEQ ID NO.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II and inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the oligonucleotide arrays and kits of group I can be used in a multitude of analyses and methods, including, for example, the two separate

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methods of groups II and III. Also included would be methods of gene expression analysis and nucleic acid purification methods and aptamer type assays.

3. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are methods which have different goals, utilize separate reagents and thus have different modes of operation. The methods of group II are directed towards immobilizing target nucleic acids while the methods of group II are directed towards detecting target nucleic acids.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as demonstrated by their different classification and recognized divergent subject matter and because inventions I-III require different searches that are not coextensive, examination of these claims would pose a serious burden on the examiner and therefore restriction for examination purposes as indicated is proper.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Juliet C. Einsmann whose telephone number is (703) 306-5824. The examiner can normally be reached on Monday through Friday, from 9:00 AM until 4:00 PM.

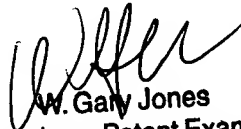
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 and (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Juliet C. Einsmann  
Examiner  
Art Unit 1634

November 12, 2002



W. Gary Jones  
Supervisory Patent Examiner  
Technology Center 1600